



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,573	07/25/2003	Yoshiaki Hirano	2003_1020A	9550
513	7590	12/19/2005	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			KEYS, ROSALYND ANN	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			1621	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,573

Applicant(s)

HIRANO ET AL.

Examiner

Rosalynd Keys

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11,12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-9 and 11 is/are allowed.
- 6) ☒ Claim(s) 12 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1, 2 and 4-9, 11, 12, 14-22 are pending.

Claims 1, 2 and 4-9, and 11 are allowed.

Claims 12 and 14-22 are rejected.

Specification

2. The amendment filed September 26, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: cyclohexene. The term alkylene may provide support for a change to cyclohexylene, but not to cyclohexene.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for cyclohexene oxide. Alkylene is a saturated

Art Unit: 1621

compound, whereas cyclohexene is an unsaturated compound. Perhaps the Applicant meant cyclohexylene.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 12 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Summer et al. (WO 91/16292), for the reasons given in the previous office action, mailed April 25, 2005.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 14-22 rejected under 35 U.S.C. 102(b) as being anticipated by Guest et al. (US 3,210,428).

Guest et al. teach preparing an aromatic ether by reacting 2,2-bis(hydroxyphenyl)ethanol

Art Unit: 1621

with propylene oxide in the presence of isopropanol and an Dowex 50 ion exchange resin (see example IV). Isopropanol has a solubility parameter of 11.5. Claims 18-22 do not require the use of the phenols disclosed therein. Thus, they are also anticipated by Guest et al.

Response to Amendment

Claim Rejections - 35 USC § 112

10. The rejection of claims 10 and 13 under 35 U.S.C. 112, second paragraph, is withdrawn since these claims have been cancelled.

Claim Rejections - 35 USC § 103

11. The rejection of claims 1, 2, 4-6 and 9 under 35 U.S.C. 103(a) as being unpatentable over Fellows et al. (US 4,639,536) is withdrawn since the limitations of claim 10 have been added to claim 1.

Response to Arguments

Rejection of Claim 12 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Summer et al. (WO 91/16292)

12. Applicant's arguments filed September 26, 2005 have been fully considered but they are not persuasive.

The Applicants argue that the process disclosed by Summer et al. would never yield an aromatic ether with low metal content according to claim 12. This argument is not persuasive because it is based upon opinion evidence and not factual evidence. Opinion testimony is not entitled to consideration when the opinion is based on the ultimate legal conclusion at issue. In the instant case the Applicants are using their opinion to try and persuade the Examiner that the instant aromatic ethers are patentable over the aromatic ether of Summer et al. Thus if the

Art Unit: 1621

Applicants believe that the Summer et al. process cannot produce the claimed aromatic ethers than the Applicants need to submit factual evidence proving their belief.

The Applicants argue that there is no indication in the Summer et al. reference that one having ordinary skill in the art would be enabled to obtain an aromatic ether having a metal content of less than 100 ppm and that the Examiner has not pointed out where in the reference that the claimed purity could be achieved using the reference process. This argument is not persuasive because the Examiner pointed out that since Summer et al. utilizes a crystallization, method to purify their aromatic ether, as does the Applicants, than Summer et al. would also be able to obtain an aromatic ether having the claimed purity. Further this argument is not persuasive because factors to be considered in determining whether a purified form of an old product is obvious over the prior art include whether the claimed chemical compound or composition has the same utility as closely related materials in the prior art, and whether the prior art suggests the particular form or structure of the claimed material or suitable methods of obtaining that form or structure. In re Cofer, 354 F.2d 664, 148 USPQ 268 (CCPA 1966) (Claims to the free-flowing crystalline form of a compound were held unobvious over references disclosing the viscous liquid form of the same compound because the prior art of record did not suggest the claimed compound in crystalline form or how to obtain such crystals.). In the instant case the claimed aromatic ether and the aromatic ether of Summer et al. have similar utility and Summer et al. disclose a method for obtaining a crystalline form of the aromatic ether.

For the above reasons this rejection is maintained.

Rejection of claims 1, 2 and 4-9, 11, and 12 under 35 U.S.C. 102(b) under 35 U.S.C. 103(a) as obvious over Hirano et al. (US 2002/0028887 A1) alone or in view of Fellows et al. (US 4,639,536)

Art Unit: 1621

13. Applicant's arguments, see page 8, filed September 26, 2005, with respect to claims 1, 2, 4-9, 11 and 12 have been fully considered and are persuasive. The rejection of claims 1, 2, 4-9, 11 and 12 has been withdrawn.

Allowable Subject Matter

14. Claims 1, 2 and 4-9, and 11 are allowed.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-TR 5:30-10:30 am.

Art Unit: 1621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalynd Keys
Primary Examiner
Art Unit 1621

December 11, 2005